

Remarks

For reasons which follow, reconsideration of this Patent Application is respectfully requested.

The Office Action mailed December 22, 2010, accepts the request for continued examination (RCE) submitted on December 9, 2010, and enters the accompanying submission, including an Amendment and an Information Disclosure Statement. Following this, consideration of the submitted Information Disclosure Statement is acknowledged. However, it has been noted that a line has been drawn through various entries listed on the accompanying Forms PTO-1449 (2), and that reasons for this have not been given in the Office Action.

It is further noted that each of the lined-through documents has previously been cited during the prosecution of this Patent Application. It is, therefore, being assumed that lines have been drawn through these various entries because each of the indicated documents has previously been considered, making such documents cumulative, and making it unnecessary to further consider such documents.

Following this, at the bottom of page 2, the Office Action of December 22, 2010, addresses the requirement for restriction made in the Office Action of March 7, 2007, and discusses the disposition of non-elected claims 19 to 38. A response to this issue will be presented later in this Reply.

The Office Action of December 22, 2010, next presents

various rejections of applicants' claims 1 to 18, including a rejection under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement, and various rejections of claims under 35 U.S.C. §103(a). It is noted, however, that claims 39 to 45 would be allowable, if suitably rewritten.

Claim 1 has been amended to incorporate the subject matter of dependent claim 39, which has been canceled, conforming amendments have been made to the dependencies of claims 40, 41 and 44, and claims 10 to 18 have been canceled from this Patent Application to remove a double patenting rejection made in a later-filed Patent Application, No. 12/655,954, which claims the benefit of the current Patent Application under 35 U.S.C. §120. However, this is not to be construed as applicants' acquiescence in the stated rejections of former claims 1 to 18, a disclaimer of any subject matter presented in this Patent Application, or applicants' right to pursue such subject matter in continuing applications.

It is respectfully submitted that claims 1 to 9 and claims 40 to 45 are in condition for allowance, leaving the matter of the disposition of non-elected claims 19 to 38.

The requirement for restriction made in the Office Action of March 7, 2007, required restriction to one of four identified groups of claims under 35 U.S.C. §121 and 35 U.S.C. §372. This included claims 19 to 28, which were designated as Group III, and claims 29 to 38, which were designated as Group IV.

Because this U.S. Patent Application was filed under the provisions of 35 U.S.C. §371, as a national stage application derived from an International Application, No. PCT/US2003/029302, the Office Action of March 7, 2007, correctly applied a "unity of invention" standard to the claims of this Patent Application under PCT Rule 13 and 37 C.F.R. §1.499 (noting Section 1893.03(d) of the Manual of Patent Examining Procedure).

Under a unity of invention standard, PCT Rule 13.1 permits applicants to include "inventions so linked as to form a single general inventive concept" in a single application. Under PCT Rule 13.2, this is proper "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". Paragraph 14 of the Office Action of December 22, 2010, at the bottom of page 20, states that:

[t]he prior art made of record fails to disclose, suggest or otherwise render obvious the use of a monitor receiving signals from the ultrasonic transducer to provide an accurate measurement indicative of the load in the thread-forming fastener and a compensator adjusting the measurement indicative of the load to compensate for effects of heating of the thread-forming fastener resulting from forming a thread in a mating component during installation.

It is respectfully submitted that because independent claims 1, 19 and 29 are each directed to the foregoing subject matter, the claims pending in this Patent Application involve "one or more of the same or corresponding special technical features", and are all properly included in this Patent Application under PCT Rule 13.

It is respectfully submitted that the foregoing is dispositive of the issue of unity of invention. However, the discussion relating to 37 C.F.R. §1.475(b) presented in the Office Actions of March 7, 2007, and May 8, 2007, is further noted. In this regard, reference is made to Part A of Section 1850 of the Manual of Patent Examining Procedure, discussing "Combinations of Different Categories of Claims" in the same application.

Part A of Section 1850 indicates that "PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: (A) In addition to an independent claim for a given product, ... an independent claim for a use of the said product...."

Claim 19 is an independent claim reciting a "method of measuring a load in a fastener" which is directed to measurements in a "thread-forming fastener". It is respectfully submitted that the recited method constitutes a "use of the said product" which supports the inclusion of claims 19 to 28 in this Patent Application, together with claims 1 to 9 and 40 to 45.

Claim 29 is also an independent claim reciting a "method of measuring a load in a fastener", which is directed to measurements in a "thread-locking fastener assembly" and which is directed to "the same or corresponding special technical features" as independent claim 19. It is, therefore, respectfully submitted that for purposes of the analyses being made under PCT

Rule 13, claim 29 recites the same method as the method of claim 19, and that claims 29 to 38 are also properly included in this Patent Application, together with claims 1 to 9, 19 to 28 and 40 to 45.

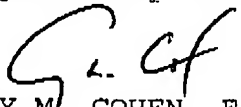
This is further supported by PCT Rule 13.3, which indicates that "[t]he determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim". It is respectfully submitted that because claim 19 and claim 29 both recite a "method of measuring a load in a fastener" which is directed to measurements made in the recited fastener, such claims should be included in this Patent Application even though "claimed in separate claims".

It is further respectfully submitted that nothing in Part A of Section 1850 of the Manual of Patent Examining Procedure would preclude the inclusion of claims 29 to 38 in this Patent Application, together with claims 1 to 9, 19 to 28 and 40 to 45. It is later stated in Part A that "[m]ore extensive combinations than those set forth above should be looked at carefully to ensure that the requirements of... PCT Rule 13... are satisfied." For reasons previously discussed, this has already been established in this Patent Application. As an example, Part A goes on to indicate that "independent claims are permissible for two related articles...." It is respectfully submitted that the "thread-locking fastener

assembly" in claim 29 and the "thread-forming fastener" in claim 19 are "related articles", justifying the inclusion of claims 19 to 28 and claims 29 to 38 in the same application.

In view of the foregoing, a reconsideration and withdrawal of the restriction requirement formulated in the Office Action of March 7, 2007, is respectfully requested. It is further respectfully submitted that in view of the foregoing, all of the pending claims 1 to 9, 19 to 38 and 40 to 45 are in condition for allowance and corresponding action is earnestly solicited.

Respectfully submitted,

  
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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571-273-8300) on: March 15, 2011.

Date:

3/15/11

  
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